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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,340	03/04/2002	Chongjun Jiang	HARD1.028A	3912
20995	7590	09/01/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			MARCANTONI, PAUL D	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/090,340	Applicant(s) JIANG, CHONGJUN	
	Examiner Paul Marcantoni	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/19/04 *amdmf and response*.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-36 and 93-145 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-36, and 93-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's arguments filed 7/19/04 have been fully considered but they are not persuasive. The applicants' amendment of claims necessitated the following grounds of rejection below:

35 USC 102/103

Claims 1, 2, 4-36, and 93-145 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leture et al. (US Patent No. 5,709,743).

Leture teaches a method of accelerating the curing of a cementitious material thus anticipating the instant invention. Even if not anticipated, overlapping ranges (ie bulk densities) would have been prima facie obvious to one of ordinary skill in the art.

The applicants amendment and changing of the preamble (thus effectively changing their invention to a differently claimed invention from a method of forming a cement material to a method of "accelerating") necessitated the following new grounds of invention:

35 USC 112 First Paragraph

Claims 1, 2, 4-36, and 93-145 are rejected under the first paragraph of 35 USC 112 as the specification as originally filed is not commensurate with their enabling disclosure.

The applicants have changed their invention to a different invention by now claiming a method of "accelerating" which is quite different than a method of *forming* a

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cement material (which is also similar to the many patents already issued and examined by the present examiner). Nevertheless, as a result of their amendment, the applicants' claims are not enabling because page 5 [0020] last paragraph of their specification specifically requires "the low density CSH or calcium silicate hydrate has an accelerating effect when added to fiber cement or concrete on a weight basis of about 0.5 to 50%...." The applicants' present claims are inclusive of *any* amount of CSH and this clearly contradicts what is stated in the specification. It is the examiner's position that this range of amounts of CSH of about 0.5 to 50 wt% is required in all independent claims and should have been placed there but was not. Note that this observation by the examiner is "not" a suggestion for future actions by applicants in prosecution but merely a commentary on the condition of their presently pending claims.

35 USC 112 Second Paragraph

Claims 1, 2, 4-36, and 93-145 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The applicants do not particularly point out and distinctly claim the specific amounts of CSH or calcium silicate hydrate required by their specification of about 0.5 to 50 wt%. It is only in this amount that there is any accelerating effect. Outside these amounts, there is no accelerating effect but that is what applicants are presently claiming by allowing for any amount of CSH in their independent claims. Thus, all independent claims and thus their dependent claims as well are indefinite. In other

words, there is no accelerating effect outside this range and it is improper for applicants to thus claim an accelerating effect outside this range which is contradictory of their specification and thus indefinite.

The applicants addition of new claims 93-145 also necessitated the following new grounds of rejection:

New Matter

Claims 93-145 are rejected under 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed:

Applicants state on page 17 of their response that they have support for "aluminosilicate" aggregate because they have support from fly ash and bottom ash which are aluminosilicates. In rebuttal, applicants do not have support for *any or all* other aluminosilicates envisioned or not specifically mentioned because they do not have literal support for any aluminosilicate other than fly ash or bottom ash. Thus, their amendment adding aluminosilicate is new matter. The applicants can overcome this by providing a Markush group of all actual aluminosilicates they have support for that are from their original specification only.

The applicants are also respectfully requested to provide the specific support for each of the new claims they add (location in the specification and or original claim) to show they do have support for these new claims. Upon this showing of specific support, it is expected that this rejection will be overcome and withdrawn.

Response:

The applicants' amendment of their preamble and thus effectively changing their invention to a method of accelerating resulted in the new grounds of rejection above and the maintaining of only Leture et al. '743. The applicants made some factual statements that grinding of CSH or calcium silicate hydrate increases its bulk density. The applicants state on page 16 of 18 of their response that one of ordinary skill in the art would not have been motivated to use a low bulk density CSH, and "in fact, the finely ground nature of the successful seeds, which likely have a bulk density outside the range of independent claims 1,35, and 36 teaches away from a low bulk density material. The applicants also argue of the unpredictability of the Leture results for their CSH accelerator.

The examiner is not convinced. First, the applicants have not provided any experimental evidence that the CSH or calcium silicate hydrate of Leture is different than their own CSH. Simply stating it likely has a bulk density outside their own is insufficient. Applicants must show conclusively with experimental evidence that Leture actually "does" (not likely) have a bulk density outside their claimed range. Also, Leture also teaches CSH and while he may grind it, the bulk density may still be in applicants' claimed bulk density range.

Also, the applicants have not provided a side by side comparison to show that their CSH accelerator is unexpected over Leture either.

The applicants are correct in their assessment regarding Leture that he seems to limit his invention to an aqueous suspension (col.4, lines17-19) yet the applicants do not

seem to limit their invention to *dry* mixing in their independent claims either. Note that applicants state on page 5 of their specification [0020] that it seems that it can be added both as dry powder (dry mixing?) or slurry which is like Leture. Nevertheless, the applicants present claims seem to read on also a slurry and not limited to dry mixing or dry powder so the prior art Leture still meets the limitations of the instant invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Mark Bell, can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755